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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,002	07/21/2003	Hideobu Mikami	1007-020	5624
47888	7590	12/13/2010		
HEDMAN & COSTIGAN, P.C. 1230 AVENUE OF THE AMERICAS 7th floor NEW YORK, NY 10020			EXAMINER GOLOBY, JAMES C	
			ART UNIT 1771	PAPER NUMBER
			MAIL DATE 12/13/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/624,002

Applicant(s)

MIKAMI ET AL.

Examiner

JAMES GOLOBOY

Art Unit

1771

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 7 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7, 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- _____ Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- _____ Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed 10/21/10 overcomes the rejection under 35 USC 112, second paragraph in the office action mailed 7/21/10, but does not overcome the prior art rejections, which are maintained below.

Claim Rejections - 35 USC § 103

2. Claims 1, 3, 7, 11-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama in view of Wulfers.

This rejection is adequately set forth in paragraph 4 of the office action mailed 7/21/10, which is incorporated here by reference.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama in view of Wulfers as applied to claims 1, 3, 11-12, and 14-15 above, and further in view of Minami.

This rejection is adequately set forth in paragraph 5 of the office action mailed 7/21/10, which is incorporated here by reference.

Response to Arguments

4. Applicant's arguments filed 10/21/10 have been fully considered but they are not persuasive. Applicant argues that there is no suggestion that the addition of the additives of Wulfers to the composition of Kageyama would prevent abnormal peeling of a rolling bearing, but does not dispute that the combination of Kageyama and Wulfers

results in the claimed composition. "Products of identical chemical composition can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). As the combination of Kageyama and Wulfers meets the compositional limitations of the claims, it must meet the intended use limitation as well.

Applicant argues that Wulfers does not disclose any information that focuses on sodium sebacate to the exclusion of other anticorrosion agents, but a teaching of alternatives is not a teaching away, and one of ordinary skill in the art would have had a reasonable expectation of success in using the sodium sebacate of Wulfers in the composition of Kageyama.

Applicant additionally reiterates previous arguments alleging that the claimed composition gives unexpectedly superior results, and that Wulfers teaches away from combining sodium sebacate with urea thickeners. The examiner maintains the positions taken in previous responses. Unexpected results commensurate in scope with the claims have not been established, and while Wulfers teaches that some organic thickeners do not afford extended operating lifetimes as measured by thermal and mechanical stability at high temperatures, this is clearly not applicable to Kageyama since Kageyama specifically teaches a urea-thickened grease with good high temperature stability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES GOLOBOY whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Goloboy/
Examiner, Art Unit 1771